

PATENT
154682-0004 Reissue
154682-0003 Reexam

R E M A R K S

Summary Statement

The proposed changes to the Abstract have been approved. The proposed changes to the Specification, and added claims 19-76, have been canceled to reduce the issues on appeal, if necessary. Applicant reserves the right to add similar claims in this or a continuing application after allowance or appeal. Claims 1 and 10 have been returned to their original form as issued and claim 77 has been added as an alternate form of claim 1 with the word "further" inserted before "comprises" in the last claim element.

The primary issue in this case is whether or not the scope of the following claim element in claim 1 is clear:

"wherein said means for associating
comprises means for embedding said
identification code on the software carrier."

This claim now stands rejected for ambiguity under 35 U.S.C. §112 on the basis that the scope of the claim is unclear and that the means for embedding may be an element of the structure of the previously recited means plus function claim element. Applicant has added claim 77 as an alternate to claim 1 to clarify this claim element and remove any possible ambiguity as follows:

"wherein said means for associating further
comprises means for embedding said
identification code on the software carrier."

No new matter has been added by this new claim and the scope of claim 77 is the same as claim 1 and has not been broadened.

1449791

10

BEST AVAILABLE COPY

PATENT
154682-0004 Reissue
154682-0003 Reexam

Detailed response to Office Action:

The prior proposed amendments to the specification stand rejected as introducing new matter. These proposed amendments have been canceled.

Applicant notes with appreciation that the replacement Abstract stands approved.

The specification stands objected to as failing to provide proper antecedent basis for the elements of claims 19 and 55. These claims have been canceled.

Claim 76 stands rejected under 35 U.S.C. §101 for being unclear as to statutory class. Claim 76 has been canceled.

Claims 1-76 stand rejected under 35 U.S.C. §112 as ambiguous. Claims 1-76 stand rejected under 35 U.S.C. §251 as improperly broadened. Claims 19-76 have been canceled.

These rejections of claims 1-18 are both based on the same premise that the scope of claim 1 is not clear. In particular, it is said to be unclear how the function "associating" can comprise structure such as the corresponding structure for the "means for embedding" and/or that correcting this proposed ambiguity would result in the omission of the structure of the prior states means.

Applicant respectfully brings the Examiner's attention to the fact that a determination under 35 U.S.C. §112 of the clarity of the scope of a claim is a matter of fact to be determined by the objective standard of whether the scope of the claim would be clear to a hypothetical person of ordinary skill in this art.

Applicant requests, if this rejection is maintain, that the Examiner specify the level of skill in this art with regard to 35

PATENT

154682-0004 Reissue

154682-0003 Reexam

U.S.C. §112 on which he bases his determination. Applicant respectfully reminds the Examiner that the Examiner has stated in a previous office action that his interpretation of the last two claim elements was believed by the Examiner to be a matter of first impression.

M.P.E.P. 35 U.S.C. §2171 which specifies the following two separate requirements under the second paragraph of 35 U.S.C. §112:

"(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

The first requirement is a subjective one because it is dependent on what the applicants for a patent regard as their invention. The second requirement is an objective one because it is not dependent on the views of applicant or any particular individual, but is evaluated in the context of whether the claim is definite - i.e., whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art.

Although an essential purpose of the examination process is to determine whether or not the claims define an invention that is both novel and nonobvious over the prior art, another essential purpose of patent examination is to determine whether or not the claims are precise, clear, correct, and unambiguous. The uncertainties of claim scope should be removed, as much as possible, during the examination process."

It is applicant's position that a person of ordinary skill in this art would consider claim 1 to have a clear scope, that is, that its scope followed the clear meaning of its words, i.e. that the means for associating comprises or includes means for embedding.

Further, the Federal Circuit has indicated that "nested" means-plus-function clauses should not be collapsed into a single element

1449791

12

PATENT

154682-0004 Reissue

154682-0003 Reexam

having the same structure, but instead must be treated separately.

For example, in Lockheed Martin Corp. v. Space Systems/Loral Inc., 66 U.S.P.Q.2d 1282 (Fed. Cir. 2003), the Federal Circuit interpreted a claim containing "nested" 112(6) elements, identified in the opinion as elements [e] "means ... to orient said satellite" and [f] "said orientation means including means ... for modifying said attitude error signal to be non-responsive to said offset in attitude...." The Federal Circuit stated that the structure corresponding to element [e] was "the magnetic torquer (64) and/or the roll thruster (66)" but that the structure corresponding to nested element [f] was "the summer (58)." Id., at 1287. Likewise, in Versa Corp. v. Ag-Bag International Ltd., 73 U.S.P.Q.2d 1191 (Fed. Cir. 2004), the claim at issue recited a "means ... for creating air channels ..., said means for creating air channels comprising positioning means" The Federal Circuit indicated that the "means ... for creating air channels" could include both the nested "positioning means" as well as "other features not recited in the claim" due to the use of the open-ended term "comprising." Id., at 1194. These cases not only clearly demonstrate that nested means-plus-function elements must be treated as separate elements, but also clearly demonstrate that they are not inherently ambiguous. Examiner's position is therefore directly at odds with Federal Circuit precedent.

Applicant has amended claim 1 be as originally filed and added claim 77 as an alternate to claim 1 which tries to avoid any such ambiguity by the addition of the word "further" to emphasize that the means for embedding is not the structure for the "means for associating".

The structure for the associating "means" remains the structure (as claimed in claim 1 as issued) for performing the function of "associating an identification code with the selected software provided to the customer" as claimed in claim 1 as issued.

The structure for the embedding "means" remains the structure (as

PATENT
154682-0004 Reissue
154682-0003 Reexam

claimed in claim 1 as issued) for embedding the identification code on the software carrier.

Once the question of a possible ambiguity in the scope of the claim has been removed, if any, the remaining major issue in this case is related to potentially improper broadening of the claim after issue. If the Examiner maintains this rejection, applicant respectfully requests that the Examiner provide greater specificity by setting forth an example of a system that would infringe claim 77 but would not infringe claim 1 as issued.

Claims 1-10, 12, 13, 15, 16, 19-28, 30, 31, 33, 34, 37-46, 48, 59, 51 and 52-76 stand rejected under 35 U.S.C. §102 as anticipated by Freeny. Claims 19-28, 30, 31, 33, 34, 37-46, 48, 59, 51 and 52-76 have been canceled. Claims 1 and 10 are amended herein.

Regarding claim 1, Freeny is said to teach means for associating an identification code, the means for associating is said to comprise mean for embedding the code on the software. The identification codes are said to comprise purchaser identification.

Applicant respectfully traverses the statement that the codes taught by Freeny comprise purchaser identification. The examples provided by the Examiner in the 35 U.S.C. §102 rejection, "owner codes, catalog reproduce code or and catalog transmit code" are clearly seller based codes not "purchaser identification" as stated by the Examiner.

The business transactions as taught by Freeny flow from a source of the software through a sales intermediate to a purchaser.

In Freeny, the information provided to the information access unit 30 of the information control machine 12 is directed to the owner-to-sales intermediate side of the transaction to ensure that the software will only be dispensed upon proper payment. To that end, the information provided in Freeny is directed to information needed by the software owner to authorize deciphering and

PATENT

154682-0004 Reissue

154682-0003 Reexam

distribution of individual copies of the software in response to a customer's request for selected software. Neither the owner nor catalog codes taught in Freeny comprise "purchaser identification" as stated by the Examiner.

Nothing in Freeny teaches or renders obvious a merchandizing system in which means are provided for associating an identification code with the selected software where the identification code comprises at least one of the following identification parameters: purchaser identification, point of sale identification and date of purchase nor in which means are provided for embedding that identification code on the software carrier, as claimed in claim 1.

Claims 2 through 10, 12, 13, 15 and 16 are dependent on claim 1. Claim 10 has been amended herein to be as originally issued.

If this rejection is maintained, applicant requests that the Examiner specify the teaching in Freeny said to teach that the identification code, associated with the software and/or embedded on the software carrier, comprises purchaser information.

Claims 11, 29 and 47 stand rejected under 35 U.S.C. §103(a) as obvious over Freeny in view of Nitori. Claims 29 and 47 have been canceled. Claim 11 is dependent on claim 1. Nothing in Freeny or Nitori, singly or combined, teaches or renders obvious a merchandizing system in which means are provided for associating an identification code with the selected software provided to the customer where the identification code comprises at least one of the following identification parameters: purchaser identification, point of sale identification and date of purchase nor in which means are provided for embedding that identification code on the software carrier as claimed in claim 1.

PATENT

154682-0004 Reissue

154682-0003 Reexam

Claims 14, 17, 18, 32, 35, 36, 50, 53 and 54 stand rejected under 35 U.S.C. §103 as obvious over Freeny in view of Scarbrough.

Claims 32, 35, 36, 50, 53 and 54 have been canceled. Claims 14, 17 and 18 are dependent directly or indirectly on claim 1. Nothing in Freeny or Natori, singly or combined, teaches or renders obvious a merchandizing system in which means are provided for associating an identification code with the selected software provided to the customer where the identification code comprises at least one of the following identification parameters: purchaser identification, point of sale identification and date of purchase nor in which means are provided for embedding that identification code on the software carrier as claimed in claim 1.

Applicant respectfully requests that the rejections herein be reconsidered in light of the amendments and arguments presented and the application be passed to issue.

Respectfully Submitted,

Date: 2/15/2006

/Norman E. Brunell Reg. No. 26533/
Norman E. Brunell Reg. No. 26,533

Irell & Manella LLP
Customer No. 29000
1800 Avenue of the Stars, Suite 900
Los Angeles, CA 90089-4276
(310) 277-1010
(310) 203-7199 Facsimile
nbrunell@irell.com